

Handwritten signature or mark.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,306	11/02/2000	James P. Beck	PH-7032	4919
7590 03/24/2004				
MICHEAL L. GOLDMAN NIXON PEABODY CLINTON SQUARE, P.O. BOX 31051 ROCHESTER, NY 14603			EXAMINER	
			COLEMAN, BRENDA LIBBY	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/704,306	BECK ET AL.	
	Examiner	Art Unit	
	Brenda L. Coleman	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-85 and 90-93 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51-73, 75-78, 81, 84, 85 and 90-93 is/are rejected.
- 7) ☒ Claim(s) 74, 79, 80, 82 and 83 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/29/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 51-85 and 90-93 are pending in the application.

This action is in response to applicant's amendment filed December 29, 2003.

Claims 51, 73, 74, 79-81, 85 and 92 have been amended and claim 93 is newly added.

Response to Amendment

Applicant's amendments and arguments filed December 29, 2003 have been fully considered with the following effect:

1. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 102, anticipation rejections of claims 1-12, 14-28, 30-36, 42-47 and 49 labeled paragraphs 5, 6, 7 and 8 of the last office action, which are hereby **withdrawn**.
2. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 103, obviousness rejections of claims 1-12, 14-28, 30-36, 42-47 and 49 labeled paragraphs 9 and 10 of the last office action, which are hereby **withdrawn**.
3. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 103, obviousness rejection of claims 30, 33 and 34 labeled paragraph 15 of the last office action, which is hereby **withdrawn**.
4. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, first paragraph rejection of claims 1-12, 14-28, 30-36, 42-47 and 49-92 labeled paragraph 17 of the last office action, which is hereby **withdrawn**.
5. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections of claims 1-12, 14-28, 30-36, 42-47 and 49-

92 labeled paragraph 18a), b) and e)-am) of the last office action, which are hereby **withdrawn**. However, with regards to the 35 U.S.C. § 112, second paragraph rejections labeled c) and d), the applicant's amendments and remarks have been fully considered but they are not persuasive.

c) The applicants stated that the rejection of claims 1-12, 14-28, 30-36, 42-47 and 49-92 under 35 U.S.C. § 112, (second paragraph) is respectfully traversed in view of the above amendments. However, the definition of R^5 and R^6 where R^5 and R^6 are **each independently** $-O-C(R^{12})_2-O-$. R^5 cannot independently be $-O-C(R^{12})_2-O-$ nor can R^6 .

d) The applicants stated that the rejection of claims 1-12, 14-28, 30-36, 42-47 and 49-92 under 35 U.S.C. § 112, (second paragraph) is respectfully traversed in view of the above amendments. However, the definition of R^7 and R^6 where R^7 and R^6 are **independently** $-O-C(R^{12})_2-O-$. R^7 cannot independently be $-O-C(R^{12})_2-O-$ nor can R^6 .

Claims 51-65, 71, 72, 76-78, 84, 85, 90-93 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for reasons of record and stated above.

6. With regards to the 35 U.S.C. § 102, anticipation rejection labeled paragraph 19 of the last office action, the applicant's amendments and remarks have been fully considered but they are not persuasive. The applicants stated that Brenner fails to teach the limitation "wherein if R^4 is hydrogen, then R^3 cannot be hydrogen or halogen

and n cannot be 0, and R⁹ cannot be hydrogen". However, claim 51 is not limited to compounds where if R⁴ is hydrogen, then R³ cannot be hydrogen or halogen and n cannot be 0, and R⁹ cannot be hydrogen.

Claims 51-55, 84 and 85 are rejected under 35 U.S.C. 102(b) as being anticipated by Brenner et al., U.S. Patent No. 4,340,600 for reasons of record and stated above.

In view of the amendment dated December 29, 2003, the following new grounds of rejection apply:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 51-73, 75-78, 81, 84, 85 and 90-93 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claims 51-55, 60-64, 66-72, 76-78, 84, 85 and 90-93 recite the limitation "-OC(O)R¹³" in the proviso for compounds of formula IB in the definition of R³.

There is insufficient antecedent basis for this limitation in the claim.

b) Claims 51-59, 66-72, 76-78, 84, 85 and 90-93 recite the limitation "-OC(O)R¹³" in the proviso for compounds of formula ID in the definition of R⁴.

There is insufficient antecedent basis for this limitation in the claim.

c) Claims 51-73, 75-78, 84, 85 and 90-93 are vague and indefinite in that it is not known what is meant by piperidine in the definition of R⁹ and R¹⁰.

- d) Claims 51-73, 75-78, 84, 85 and 90-93 are vague and indefinite in that it is not known what is meant by the proviso where R^9 or R^{10} are taken together.
- e) Claims 51-78 84, 85 and 90-93 are vague and indefinite in that it is not known what is meant by the proviso at the end of the claim wherein "if R^4 is hydrogen, then R^3 cannot be hydrogen, n cannot be 0, and R^9 cannot be hydrogen" since these compounds are already excluded by the proviso where R^3 and R^4 are not both hydrogen. (Claims 51-78
- f) Claim 81 recites the limitation where the variables " R^2 , R^3 and R^4 " on the phenyl ring and " R^1 " in the seven position of the isoquinoline ring". There is insufficient antecedent basis for this limitation in the claim.
- g) Claim 93 is vague and indefinite in that it is not known what is meant by the disorder "psychiatric symptoms anger".

Claim Objections

8. Claims 74, 79, 80, 82 and 83 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00 Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brenda Coleman
Primary Examiner Art Unit 1624
March 21, 2004